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Total Number of Pages in This Submission

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Application Number	09/615,473
Filing Date	07/13/2000
First Named Inventor	Marcus Escobosa
Art Unit	2612
Examiner Name	Zimmerman, Brian A.
	81230.56US1

ENCLOSURES (Check all that apply)

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Firm Name	Customer No. 34018 Greenberg Traurig, LLP		
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Date	February 15, 2007	Reg. No.	35,906

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant:	Escobosa)	Examiner:	Zimmerman, Brian A.
)		
Serial No.:	09/615,473)	Art Unit:	2635
)		
Filed:	July 13, 2000)	Attny Doc.:	81230.56US1
)		
Title:	Customizable And)		
	Upgradeable Devices And)		
	Methods Related Thereto)		

REPLY BRIEF

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Appellant hereby submits this Reply to the Examiner's Answer dated January 3, 2006.

This Reply Brief is being filed in triplicate.

The Commissioner is hereby authorized to charge any fee deficiency or credit
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By: _____

Ranni Matar

REMARKS

In accordance with 37 CFR §§ 41.41(a)(1) and 41.43(b), Appellant hereby submits this Reply Brief in response to the Examiner's Answer.

As concerns the Related Appeals And Interferences, it is noted that in related application No. 10/151,635 the rejection of the claims was overturned by the Board on December 20, 2006. A copy of the decision is attached hereto.

In the Examiner's Answer the rejection of independent claim 54 under 35 U.S.C. § 102 as being anticipated by Chiloyan (U.S. Patent No. 6,008,735) was withdrawn. The withdrawn rejection was, however, replaced with a rejection under 35 U.S.C. § 103. As such, independent claim 54 now stands rejected under 35 U.S.C. § 103 as being rendered obvious by Chiloyan alone.

In response to this new ground of rejection, it is respectfully submitted that, when rejecting a claim under 35 U.S.C. § 103, it is incumbent upon the Examiner to establish a factual basis to support the legal conclusion of obviousness. *In re Fine*, 837 F.2d 1071, 1073 (Fed. Cir. 1988). To this end, the Examiner must show that there is a teaching, motivation, or suggestion of a motivation to modify or combine the reference(s) relied upon as evidence of obviousness. *Id.* at 1343. As concerns the teaching, motivation, or suggestion to modify or combine references, the Examiner cannot simply reach conclusions based on the Examiner's own understanding or experience - or on his or her assessment of what would be basic knowledge or common sense. Rather, the Examiner must point to some concrete evidence in the record to support the conclusions of obviousness. *In re Zurko*, 258 F.3d, 1379, 1386 (Fed. Cir. 2001).

In the rejection of independent claim 54 it was acknowledged that, while Chiloyan discloses the use of a computer (PC 26) as a source of code sets to be downloaded to a remote

control at Col. 5, lines 25-35, Chiloyan fails to disclose that the computer (PC 26) functions to select a plurality of function code sets that have been identified as being candidates for commanding operations of the type of consumer electronic device specified by the user input and to cause at least a subset of each of the plurality of the selected command code sets to be downloaded from the computer to the remote control. While Chiloyan was acknowledged to be missing at least these expressly recited claim elements, it was nevertheless asserted that “by downloading only the candidate code sets, the communication of such code sets would be less than communicating all possible code sets, and the user experimentation phase would be more efficient since the user would only have to test the candidate code sets as opposed to all possible code sets stored at the computer.” (Examiner’s Answer, page 4). Thus, based upon this assertion, it was concluded that it would have been obvious to modify Chiloyan to arrive at the invention claimed since doing so would increase the efficiency in the programming of the remote control.

With respect to the assertion upon which the conclusion of obviousness is based, it is respectfully noted that no reference of record teaches or suggests that it would even be desirable to increase the efficiency in the user experimentation phase of a remote control, let alone by downloading and testing only candidate codes sets as opposed to all possible code sets stored at a computer as is claimed. This is particularly evidenced by the failure of the Examiner to cite to any reference of record where any such suggestion may be found. Therefore, since the espoused motivation for modifying Chiloyan fails to be taught or suggested in any reference of record, it is respectfully submitted that it evident that the conclusion of obviousness set forth within the Examiner’s Answer is based upon nothing more than an assessment of what the Examiner considers to be basic knowledge or common sense which, as discussed above, is contrary to the

requirements of a *prima facie* case of obviousness. For at least this reason it is respectfully submitted that the rejection of independent claim 54 under 35 U.S.C. § 103 must be withdrawn.

Still further, it is respectfully submitted that, when Chiloyan is considered in its entirety, the espoused motivation for modifying Chiloyan is speculative at best. In this regard, it is respectfully noted that there simply is no need to increase the efficiency in the user experimentation phase of the Chiloyan remote control since, as acknowledged by the Examiner, Chiloyan *already* provides for the testing of only those command codes stored within the remote control that are appropriate for a brand and consumer electronic device that is specified by a user to the remote control. Thus, it will be readily appreciated that, since Chiloyan already provides for the testing of only those command codes stored within the remote control that are appropriate for a brand and consumer electronic device that is specified by a user to the remote control, it will simply make no difference to the efficiency in the user experimentation phase of the Chiloyan remote control if all possible codes sets are downloaded into the remote control before the testing procedure is commenced as compared to if only candidate code sets are downloaded into the remote control before the testing procedure is commenced. Thus, for the additional reason that it is evident that the motivation to modify Chiloyan is speculative at best, it is respectfully submitted that the rejection of independent claim 54 must be withdrawn.

Yet further, even if one of skill in the art was motivated to modify Chiloyan to thereby increase the overall efficiency in the programming of a remote control in the manner espoused in the rejection of the claims, it is respectfully submitted that, absent the disclosure within the Appellant's application, this motivation alone would still not have caused one of skill in the art to necessarily arrive at the exact invention that is recited in independent claim 54. For example, if one of skill in the art were to consider the teachings within Kemink (WO 0017738), to increase

the overall efficiency in the programming of a remote control, i.e., to more efficiently configure a remote control to command operations of a consumer electronic device, Kemink would not suggest modifying Chiloyan to allow for the downloading and testing of an identified, selected plurality of function code sets as is claimed but would instead suggest modifying Chiloyan to remove the user experimentation phase in favor of the downloading from a computer to a remote control of the single command set that is determined by the system of Kemink to be appropriate for commanding operations of a consumer electronic device, i.e., the single command set the configuring system of Kemink identifies as being appropriate based upon a user specified model number. As will be evident, selecting and downloading a single command set to thereby immediately configure a remote control to command a consumer electronic device as taught by Kemink would certainly meet the objective of increasing the overall efficiency in the programming of a remote control to command operations of a consumer electronic device in keeping with the motivation espouse in the rejection of the claims but would not cause one of skill in the art to arrive at the exact invention that is set forth within the claims. Thus, for the yet further reason that even the mere identification of a motivation to modify Chiloyan (which still fails to be found in any reference of record), fails to itself evidence that one of skill in the art would have necessarily been led to the exact invention that is expressly set forth within the claims, it is respectfully submitted that the rejection of independent claim 54 must be withdrawn.

It is for at least these same reasons - as well as those set forth in the Appellant's Appeal Brief, e.g., that the teachings of Chiloyan and Kemink are in direct conflict and thus, not even properly combinable as Kemink suggests changing the very principle of operation of the system of Chiloyan - it is respectfully submitted that the combined teachings of Chiloyan and Kemink cannot be said to present a *prima facie* case of obviousness with respect to independent claim 71.

Conclusion

It is again respectfully submitted that the application is in good and proper form for allowance. Such action of the part of the Board is respectfully requested.

Respectfully Submitted;

A handwritten signature in black ink, appearing to read 'G. Jarosik', written over a horizontal line.

By:

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Date: February 15, 2007

CHI 56652855v1

The opinion in support of the decision being entered today was not written for publication and is not binding precedent of the Board.

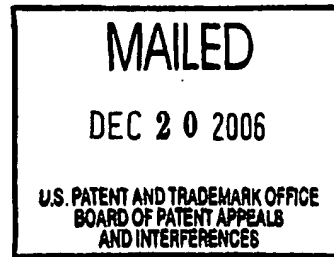
UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte PATRICK H. HAYES,
JAMES N. CONWAY, JR., ROBERT P. LILLENES,
AND PAUL D. ARLING

Appeal No. 2007-0421
Application No. 10/151,635

ON BRIEF



Before THOMAS, KRASS, and JERRY SMITH, Administrative Patent Judges.

KRASS, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal from the final rejection of claims 20-34 and 36. Claims 35 and 37-39 have been indicated by the examiner in the answer as being directed to allowable subject matter and are no longer on appeal before us.

The invention is directed to universal remote controllers. In particular, the inventive method involves using identity data regarding a particular appliance to be controlled, wherein that identity data is uploaded from the controlling device to an internet server to retrieve from an internet database control codes to which the identified appliance is adapted to respond.

Independent claim 20 is reproduced as follows:

20. A method for configuring a controlling device to command the operation of an appliance, comprising:

receiving into the controlling device data that functions to identify the appliance;

causing the data that functions to identify the appliance to be uploaded from the controlling device to a device having Internet connectivity;

causing the data that functions to identify the appliance to be uploaded from the device having Internet connectivity via a wide area communication link to an Internet server having access to a database of control codes for commanding the operation of a plurality of appliances of different types and different manufacturers;

using at the Internet server the data that functions to identify the appliance to retrieve from the database control codes to which the appliance is adapted to respond;

receiving the control codes retrieved from the database at the device having Internet connectivity;

causing the control codes retrieved from the database to be downloaded from the device having Internet connectivity into the controlling device; and

storing the control codes retrieved from the database in the controlling device whereby the control codes are available for the use in commanding the operation of the appliance.

The examiner relies on the following references:

Allport	6,104,334	Aug. 15, 2000
Yang	6,133,847	Oct. 17, 2000
LoVasco et al. (LoVasco)	6,208,853	Mar. 27, 2001
Foster	6,211,870	Apr. 03, 2001
Walsh et al. (Walsh)	6,230,970	May 15, 2001

Claims 20-34 and 36 stand rejected under 35 U.S.C. § 103. As evidence of obviousness, the examiner offers Yang and Allport with regard to claims 20-24, 27, 34, and 36, adding Foster with regard to claims 25, 29, and 30, but adding LoVasco with regard to claims 26 and 31-33. With regard to claim 28, the examiner offers Yang, Allport, LoVasco and Walsh.

Reference is made to the briefs and answer for the respective positions of appellants and the examiner.

OPINION

In rejecting claims under 35 U.S.C. § 103, it is incumbent upon the examiner to establish a factual basis to support the legal conclusion of obviousness. See In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988). In so doing, the examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966). The examiner must articulate reasons for the examiner's decision. In re Lee, 277 F.3d 1338, 1342, 61 USPQ2d 1430, 1433 (Fed. Cir. 2002). In particular, the examiner must show that there is a teaching, motivation, or suggestion of a motivation to combine references relied on as evidence of obviousness. Id. at 1343, 61 USPQ2d at 1433-34. The examiner cannot simply reach conclusions based on the examiner's own understanding or experience – or on his or her assessment of what would be basic knowledge or common sense. Rather, the examiner must point to some concrete evidence in the record in support of these findings. In re Zurko, 258 F.3d 1379, 1386, 59 USPQ2d 1693, 1697 (Fed. Cir. 2001). Thus the examiner must not only assure that the requisite findings are made, based on evidence of record, but must also explain

the reasoning by which the findings are deemed to support the examiner's conclusion. However, a suggestion, teaching, or motivation to combine the relevant prior art teachings does not have to be found explicitly in the prior art, as the teaching, motivation, or suggestion may be implicit from the prior art as a whole, rather than expressly stated in the references. The test for an implicit showing is what the combined teachings, knowledge of one of ordinary skill in the art, and the nature of the problem to be solved as a whole would have suggested to those of ordinary skill in the art. In re Kahn, 441 F.3d 977, 987-88, 78 USPQ2d 1329, 1336 (Fed. Cir. 2006) citing In re Kotzab, 217 F.3d 1365, 1370, 55 USPQ2d 1313 (Fed. Cir. 2000). See also In re Thrift, 298 F.3d 1357, 1363, 63 USPQ2d 2002, 2008 (Fed. Cir. 2002). These showings by the examiner are an essential part of complying with the burden of presenting a prima facie case of obviousness. Note In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). If that burden is met, the burden then shifts to the applicant to overcome the prima facie case with argument and/or evidence. Obviousness is then determined on the basis of the evidence as a whole and the relative persuasiveness of the arguments. See Id.; In re Hedges, 783 F.2d 1038, 1040, 228 USPQ 685, 687 (Fed. Cir. 1986); In re Piasecki, 745 F.2d 1468, 1472, 223 USPQ 785, 788 (Fed. Cir. 1984); and In re Rinehart, 531 F.2d 1048, 1051, 189 USPQ 143, 146-147 (CCPA 1976). Only those arguments actually made by appellant have been considered in this decision. Arguments which appellant could have made but chose not to make in the brief have not been considered and are deemed to be waived [see 37 CFR § 41.37(c)(1)(vii) (2004)].

Turning first, to independent claim 20, the examiner finds that Yang describes the claimed subject matter but for causing the data that functions to identify the appliance to be uploaded from the remote controller having internet connectivity via a wide area communication link to an internet server, and using, at the internet server, the data that functions to identify the appliance to retrieve from the database control codes to which the appliance is adapted to respond, and receiving the control codes retrieved from the database at the device having internet connectivity.

The examiner turns to Allport for these limitations, pointing specifically to column 22, lines 10-32 (for causing data that functions to identify the appliance to be uploaded from the device), to column 26, lines 11-16 (for uploading data associated with the appliance identification to specify a device IPS associated library data or command data), and to column 29, lines 12-15 (for the rest of the deficient limitations). See page 5 of the answer.

The examiner concludes that it would have been obvious to include causing the data that functions to identify the appliance learned by the remote control to be uploaded from the remote control using internet connectivity to an internet server having a database of control codes, sending the database control codes to the remote controller to program the remote controller in the device of Yang because Allport teaches using data that specifies the appliance to be uploaded from the controller using the internet to retrieve from the database control codes to which the appliance is adapted to respond, and receiving the control codes retrieved from the database at the device for the purpose of providing wider product availability. See pages 5-6 of the answer.

Appellants' response is to argue that neither reference teaches or suggests a download mechanism including accessing, via a network, a database of control codes for commanding operations of a plurality of different appliances and using identity data uploaded from the controlling device to retrieve from that database those control codes to which the appliance so identified is adapted to respond. Appellants note the examiner's reliance on column 22, lines 10-32, of Allport, but find nothing therein describing that anything is uploaded from the remote control to an internet server, let alone for the purpose of retrieving those control codes to which an identified appliance is adapted to respond (see page 8 of the principal brief).

We agree with appellants.

The claimed feature of uploading the identifying data to an internet server and using that server to retrieve control codes from a database is nowhere suggested in Yang and the examiner admits as much. Therefore, in order for the outstanding rejection to have any legs at all, such a feature must be described or suggested in Allport before we even reach the question of combinability.

We simply do not find such features to be suggested by Allport. It is true that Allport suggests, at column 26, lines 12-16, for example, that data for specific devices may be stored on an internet server and then retrieved, as needed. But we find no indication therein of receiving into the controlling device data that functions to identify an appliance and then uploading data identifying a particular appliance *from the controlling device* which then uploads data to a device

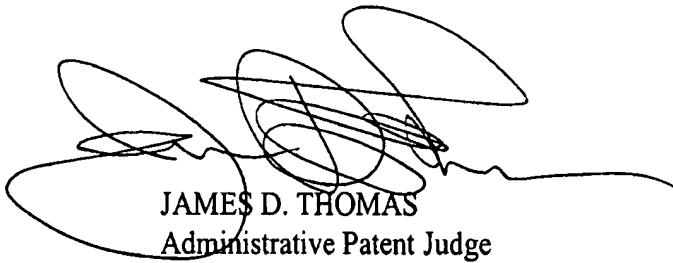
having internet connectivity which device then uploads the data identifying the appliance to an internet server and then using that server to retrieve control codes from a database.

In short, we agree with appellants, at pages 3-4 of the reply brief, when they state that Allport fails to disclose or suggest “the desirability of using identity data uploaded from the controlling device to an internet server to retrieve from an internet database those control codes to which the appliance so identified to the internet server is adapted to respond.” The examiner has offered nothing to convince us otherwise.

Since these features of the independent claim are not taught or suggested by the applied references, and the references (LoVasco, Walsh, and Foster) applied to dependent claims 25, 26, and 28-33 do not provide for the deficiencies of Yang and Allport, we will not sustain any of the rejections under 35 U.S.C. § 103.

Accordingly, the examiner’s decision rejecting claims 20-34 and 36 under 35 U.S.C. § 103 is reversed.


REVERSED



JAMES D. THOMAS
Administrative Patent Judge



ERROL A. KRASS
Administrative Patent Judge



JERRY SMITH
Administrative Patent Judge

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Appeal No. 2007-0421

Application No. 10/151,635

GREENBERG & TRAURIG, L.L.P.

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